

REMARKS

Applicant appreciates the detailed examination evidenced by the Official Action mailed November 22, 2006 (hereinafter "the Official Action"). In response, Applicant respectfully maintains that the pending claims are patentable over Sterkel and the newly applied Cassidy reference. For example, neither Sterkel nor Cassidy discloses or suggests "transferring data from/to an electronic device when . . . information used to register the electronic device with a wireless communications network is absent from the electronic device." *Independent Claim 1*. To the contrary, the devices discussed in Sterkel and Cassidy both include information used to register the respective device with a network. Accordingly, Applicant respectfully submits that the pending claims are patentable over the cited references for at least the reasons described herein.

The Claims Comply With Section 112.

Claims 1, 29, and 31 stand rejected under 35 U.S.C. § 112, second paragraph. *Official Action, page 2*. After reviewing the Official Action, Applicant is unsure as to the basis for the rejections under Section 112. For example, the rejection of Claim 1 alleges that there is insufficient antecedent basis for the recitation of "from/to an electronic device" in line 3. Specifically, the cited recitation does not refer to any previous recitations of the claim. Accordingly, a rejection based on an alleged "insufficient antecedent basis" is improper.

With regard to Claim 29, the rejection alleges that there is insufficient antecedent basis for the recitation of "memory of an electronic device" in line 3. Again, Applicant is unsure as to the basis of this rejection as the cited recitation does not refer to any previous recitation in the claim and, therefore, the rejection based on "insufficient antecedent basis" is inappropriate.

Applicant also maintains that the rejection of Claim 31 based on the cited recitation of "an electronic device" in lines 5 and 6 thereof is improper as this recitation does not refer to any previous recitations of the claim. Accordingly, a rejection based on an alleged "insufficient antecedent basis" is improper.

In view of the above, Applicant respectfully requests withdrawal of the rejections under Section 112 or, in the alternative, clarification of these rejections.

The Independent Claims Are Patentable Over The Cited References

Claims 1-38 stand rejected under 35 U.S.C. § 103 over Sterkel in view of U.S. Patent No. 6,480,725 to Cassidy et al. ("Cassidy"). *Official Action, page 3*. In response, Applicant respectfully traverses the rejection based on Sterkel and Cassidy as even if these references were combined, the combination would not disclose or suggest, at least, "transferring data to/from an electronic device when . . . information used to register the electronic device with a wireless communications network is absent from the electronic device" as recited in independent Claims 1, 15, 29, 31, and 32. For example, independent Claim 1 recites in-part:

transferring data from/to an electronic device when a removable Subscriber Identity Module (SIM) that stores **information used to register the electronic device with a wireless communications network is absent from the electronic device.**

Independent Claims 15, 29, 31, and 32 include similar recitations.

To establish a *prima facie* case of obviousness, the prior art references (when combined) must teach or suggest all the claim limitations. Even if Sterkel and Cassidy were combined, the combination would not disclose or suggest the above-highlighted recitations.

The specification as filed describes the recitation of "absent from" as follows:

It will be understood that, as used herein, the phrase **"absent from" can refer to the information used by the radiotelephone to otherwise register with the network.** Therefore, embodiments of radiotelephones according to the invention can be provided where a SIM card dummy can be present in the radiotelephone, where the SIM card dummy does not include the information used to register the radiotelephone with the network 10. *U.S. Patent Application Serial No. 10/617,325, page 11, lines 6-10 (emphasis added).*

As shown above by the exemplary portion of Applicant's disclosure, the recitation of "absent from" refers to the fact that information used by the radiotelephone to register the radiotelephone with the network **is absent from the radiotelephone.**

The fact that the enhanced service module 204 of Sterkel is an **optional element** indicates that the radiotelephone discussed therein would operate normally even without the enhanced service module present. Accordingly, Sterkel does not disclose or suggest "transferring data to/from an electronic device when . . . information used to register the electronic device with a wireless communications network is absent from the electronic device," as Sterkel would operate with or without the enhanced service module 204. Therefore, the device in Sterkel provides information used to register with the network when the enhanced service module 204 is absent.

Furthermore, the enhanced service module 204 of Sterkel is not a SIM that stores information used to register a radiotelephone with the network. In fact, the enhanced service module 204 is shown as having a SIM interface 250. Applicant respectfully submits that the enhanced service module 204 of Sterkel does not disclose or suggest a SIM as the enhanced service module is shown as having an interface to a SIM.

The Office Action seems to imply that the enhanced service module 204 is equivalent to a SIM. However, Applicant respectfully points out that Sterkel, column 5, lines 11-30, clearly points out that the enhanced service module 204 does not include a SIM, but can include an interface to a SIM:

The system board 240 may also have built in interfaces for communication with external devices. These interfaces may include a subscriber identity module (SIM) interface 250 for accepting an external SIM containing subscriber information, a Y-cable interface 252, an infrared device adapter (IRDA) interface 254 and a BLUETOOTH® adapter 256. The SIM interface 250 allows quick and easy connection of a SIM defining user identity and preferences, and thus allows quick and easy configuration of the telephone 102 for a particular user.

Any or all of the interfaces 250-256 may be designed into the system board or alternatively a user may select optional interface cards which may be connected using the slots 244-248, in order to provide desired interface capability. It is preferred, however, that any design include the SIM interface 250 in order to provide compatibility with a SIM module. The enhanced services module 204 also includes a telephone interface 258 to provide an interface to the basic telephone module 202 through the interface

module 206. The telephone interface 258 is connected to a ZIF connector 260. *Sterkel, Column 5, lines 11-20.*

Accordingly, contrary to assertions in the Official Action, the enhanced service module 204 of Sterkel is not a SIM, but is rather an optional add-on device which provides the ability to off-load non real time functions from the radiotelephone processor to a coprocessor. Accordingly, Sterkel does not disclose or suggest at least these recitations of the claims.

Cassidy also does not disclose or suggest the recitations shown above to be missing from Sterkel. In particular, although Cassidy does discuss that the SIM may be absent from the device, in such cases **Cassidy uses information stored in the electronic memory to register a device with the network:**

FIG. 3a shows the operation of a telephone according to an embodiment of the present invention when there is no SIM card present. That is, where the telephone used the ID data on the EEPROM 6 last time it was used and no SIM card has been inserted since. In this situation, the phone operation is that of a conventional phone solely having an internal information store (EEPROM 6). In this instance, the microprocessor 4 checks whether a security code is required (step 301). If no security code is required, the phone is ready to use. Alternatively, if a security code is required to be entered, the microprocessor 4 checks whether it has indeed been entered. Once the microprocessor is aware that the security code has been entered, that code is checked to see if it is correct (i.e. that it corresponds to the security code associated with the telephone) (step 203). Assuming the code is correct, the phone is then ready to use. *Cassidy, Column 5, lines 38-54.*

As shown above by the cited passage of Cassidy, even if the SIM is absent from the telephone, the telephone relies on the information stored in the EEPROM 6 to register the device with the network (*i.e.*, to make the phone ready for use). Therefore, as understood by Applicant, the device in Cassidy will use whatever information is available (*i.e.*, information on the SIM or in the electronic memory) to register the device with the network so that the device may be used.

However, Cassidy does not disclose or suggest transferring data from/to an electronic device when “. . . information used to register the electronic device with a wireless communications network is absent from the electronic device.” In other words, even if a SIM that stored information used to register a device with the

network were absent from the telephone in Cassidy, the telephone therein would rely on the electronic information stored in the EEPROM to register the device with the network so the device may be used. Therefore, even in cases where the SIM is absent from the telephone in Cassidy, the device still includes information that is used to register the electronic device with the network.

Accordingly, even if Sterkel and Cassidy were combined, the combination would not disclose or suggest, at least, transferring data from/to an electronic device when “. . . information used to register the electronic device with a wireless communications network is absent from the electronic device.” Independent Claims 1, 15, 29, 31, and 32.

Furthermore, a *prima facie* case of obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and there must be a reasonable expectation of success of the combination. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See MPEP § 2143. As stated by the Court of Appeals for the Federal Circuit, to support combining references in a § 103 rejection, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement is not met by merely offering broad, conclusory statements about teachings of references. *In re Dembiczak*, 50 USPQ2.d 1614, 1617 (Fed. Cir. 1999).

Applicant respectfully submits that there is no clear and particular evidence of a motivation or suggestion to combine Sterkel and Cassidy as required under Section 103. In particular, the cited passage of Cassidy (providing the alleged motivation for the combination) merely discusses the nature of a conventional SIM (i.e., what kind of components are typically included on a SIM:

This memory module receiver 10 is designed so that such a memory module can be plugged in or removed in a relatively straight forward manner. The receiver may form a recess or compartment in the handset housing 2. As well as containing subscriber related data, the SIM card may also contain other subscriber related information or applications, for example, repertory dialing information, charge meter information, function

control information, an authentication algorithm etc. It is noted here that a SIM card is not a passive memory card, but also a processor card which includes not only a memory, but a facility for internally processing information, as is well known in the art. The data stored in the SIM is used by the microprocessor 7 to enable the telephone to communicate on the appropriate network. Other data stored on the SIM card is used by the microprocessor for, for example, to control, modify, or monitor, the operation of the telephone in a conventional manner. *Cassidy, Column 4, lines 40-57.*

As shown by the above-cited passage from Cassidy, relates to the components of a conventional SIM, which teaches away from a combination with Sterkel. In particular, Sterkel already discusses a SIM, which is in-fact, separate from the enhanced service module 204 that the Office Action alleges to be equivalent to a SIM. Applicant submits that there is no clear and particular evidence of a motivation or suggestion to combine Sterkel with Cassidy as the SIM discussion in Cassidy actually teaches away from a combination with Sterkel as Sterkel already includes a SIM. Further, replacing the enhanced service module 204 with the conventional SIM components discussed in Cassidy would frustrate the objective of Sterkel (that is the ability to off-load the non-critical functions from the processor). Applicant submits that this objective of Sterkel would be frustrated if the enhanced service module 204 were replaced by a conventional SIM. Accordingly, the evidence offered by the Official Action does not meet the standard for clear and particular evidence of a motivation or suggestion to combine Sterkel and Cassidy as required under Section 103, and moreover, actually teaches away from a combination as outlined above.

In view of the above, Applicant respectfully submits that independent Claims 1, 15, 29, 31, and 32 are patentable over Sterkel and Cassidy for at least the reasons described above. Furthermore, the dependent claims are patentable for at least the reasons described above in reference to the independent claims.

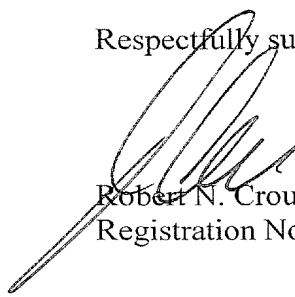
CONCLUSION

Applicant has shown herein that the claims comply with Section 112 or, alternatively, have requested further clarification regarding the basis of these rejections. Applicant has also shown why even if Sterkel and Cassidy were combined as alleged, the combination would not disclose or suggest all the recitations of the

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claims. Furthermore, Applicant has shown that there is no clear and particular evidence of a motivation or suggestion to combine these references, and further, there is evidence that Cassidy actually teaches away from a combination with Sterkel. Accordingly, Applicant respectfully requests the withdrawal of all rejections and the allowance of all claims in due course. If any informal matters arise, the Examiner is encouraged to contact the undersigned by telephone at (919) 854-1400.

Respectfully submitted,



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